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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/114,973	07/14/1998	WILLIAM F. DOVE	960296.95491	9862

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EXAMINER
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WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

38

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/114,973

Applicant(s)

DOVE ET AL.

Examiner

Joseph T. Woitach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4-16, 25-31, 34-42 is/are allowed.
- 6) ☒ Claim(s) 3, 17-24, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 10, 2003 has been entered.

**DETAILED ACTION**

Applicants' petition for revival of the unintentionally abandoned application has been approved (see papers number 35 and 37).

As indicated in the request for continued examination the response filed May 30, 2003, has been entered. Claims 3 and 32 have been amended. Claims 1-42 are pending and currently under examination.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 37 CFR 1.118 (a) states that "No amendment shall introduce new matter into the disclosure of an application after the filing date of the application". In the instant case, review of the portion of the specification pointed to for support of the instant amendments (page 13) it is found that the specification only supports that the "tenth percentile" is associated with "enhanced" phenotype and the ninetieth percentile" is associated with "suppressed" phenotype. Review of the instant specification does not provide literal nor figurative support for the instantly claimed amendment.

To the extent that the claimed compositions and/or methods are not described in the instant disclosure, claims 3 and 32 are also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, since a disclosure cannot teach one to make or use something that has not been described.

MPEP 2163.06 notes "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." MPEP 2163.02 teaches that "Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application.

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MPEP 2163.06 further notes "When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not "new matter" is involved. Applicant should therefore specifically point out the support for any amendments made to the disclosure"

Claims 17-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

*Vas-Cath Inc. v. Mahurkar*, 19USPQ2d 1111 (Fed. Cir. 1991), clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." *Vas-Cath Inc. v. Mahurkar*, 19USPQ2d at 1117. The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *Vas-Cath Inc. v. Mahurkar*, 19USPQ2d at 1116. In the instant case, while a written description for a "modifier of an index phenotype" and a "a single nucleotide mapping polymorphism genetically linked to the single point mutation" is terminology generally understood in the art by the skilled artisan, it is unclear how one specifically determines these and what specific alterations are encompassed by the claims. The specification provides a detailed outline to perform methods of genetic analysis and the means to determine the genetic linkage between alleles. However, a method to search for such alleles does not define the allele or any given phenotype. The claims broadly encompass any

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combination of allele and any definable phenotype. Importantly, the claimed products are set forth as products by process requiring the skilled artisan to practice a method in order to determine if a given animal meets the limitations of the claims and potentially falls within the metes and bounds of the claims. The potential starting products comprise an animal with a random point mutation, and requires that one obtain a index phenotype so that one can ultimately choose and verify an affect on an index phenotype. The specification fails to provide any clear guidance to what these alleles or altered genes would be without specifically testing for them. The specification fails to adequately describe all the possible combinations encompassed by the claims. The claimed invention as a whole is not adequately described if the claims require essential or critical elements which are not adequately described in the specification and which are not conventional in the art as of Applicants effective filing date. Possession may be shown by actual reduction to practice, clear depiction of the invention in a detailed drawing, or by describing the invention with sufficient relevant identifying characteristics (as it relates to the claimed invention as a whole) such that a person skilled in the art would recognize that the inventor had possession of the claimed invention. *Pfaff v. Wells Electronics, Inc.*, 48 USPQ2d 1641, 1646 (1998). In the instant case, Applicants have asserted that the claimed methods can reveal segregating mutations, with which assertion Examiner would agree, however a method to determine whether a claimed product falls within the scope of the claims fails to adequately describe the product itself. The skilled artisan cannot envision all the possible specific combinations of mutations, alleles and phenotypes, and therefore conception is not achieved until reduction to practice of an adequate representation of the full breadth of claimed invention has occurred, regardless of the complexity or simplicity of the method used. The basis of the

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rejection does not focus only on the breadth of any mutation or phenotype because adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of identifying it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016 (Fed. Cir. 1991). In this case, even practicing the simple steps of the method does not result in the claimed product as evidenced by the fact that it requires a step of verification (see claims 19 and 21). With respect to claim 17, apparently specific genetic conditions are recited, however the specification fails to clearly set forth a correlation of specific mutations with specific phenotypes. The general description of function fails to clearly set forth an adequate description of the claimed non-human animals.

Applicants attention is drawn to the decision of *The Regents of the University of California v. Eli Lilly and Company* (CAFC, July 1997) wherein it was stated:

In claims involving chemical materials, generic formulas usually indicate with specificity what the generic claims encompass. One skilled in the art can distinguish such a formula from others and can identify many of the species that the claims encompass. Accordingly, such a formula is normally an adequate written description of the claimed genus. In claims to genetic material, however, a generic statement such as "vertebrate insulin cDNA" or "mammalian cDNA," without more, is not an adequate written description of the genus because it does not distinguish the claimed genus from others, except by function. It does not specifically define any of the genes that fall within its definition. It does not define any structural features commonly possessed by members of the genus that distinguish them from others. One skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene does, rather than what it is. See *Fiers*, 984 F.2d at 1169-71, 25 USPQ2d at 1605-06 (discussing *Amgen*). It is only a definition of a useful result rather than a definition of what it achieves as a result. Many such genes may achieve that result. The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369, 372-373 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.").

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Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481, 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence. In the instant case, the method itself starts with random mutations and requires the identification of undefined phenotypes associated with said mutation. Claiming the product as a matter of function as it is related to practicing the method, in this case a non-human animal with any phenotype, does not provide adequate description of the claimed products themselves, thus the rejected claim fails to meet the written description requirement under 35 U.S.C. 112, first paragraph.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The amendments to claims 3 and 32 are noted indicating a specific percentile relative to an index phenotype. The claim is unclear because how the artisan accesses these percentiles is not specifically set forth. The literal support for the amendment at page 13 of the specification is noted, however these percentile are relative to enhanced or suppressed phenotypes, respectively. It is unclear how the phenotype is determined and expressed as an absolute number in order to establish a percentile. Moreover, the specification teaches that the changes can be subtle and



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become more significant with backcross and subsequent cross indicating that any phenotype is given to change and variation. The metes and bounds of the claim can not be determined because the nature of the phenotype and how the phenotype is specifically quantified is not clearly set forth in the specification and would be subject to each artisans interpretation.

***Conclusion***


Claims 1, 2, 3-17 26-31 and 34-42 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571) 272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach

  
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